

REMARKS

Applicant has reviewed the Final Office Action mailed April 4, 2003. Claims 2, 7, 9-11, 13, 18, and 21-23 are being amended and claims 26 through 48 are being added by this Response. Thus, claims 2 through 11 and 13 through 48 are pending in the application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Claim Rejection Under 35 U.S.C. §102

Claims 2-4, 6, 13-14, 17, and 25 were rejected under 35 U.S.C. §102(b) as being anticipated by Clark, Jr. et al., United States Patent 5,785,913. Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Regarding claims 2 and 13, the Patent Office references col. 2, lines 10-65 and col. 4, lines 10-33 of Clark, Jr. et al. for teaching of “magnetic shielding alloy” as claimed in claims 2 and 13. However, none of the referenced portions, nor anywhere else in the submitted reference, teach or suggest this material. Further, nowhere in the submitted reference is there a teaching of shielding. Therefore, it is respectfully submitted that a prima facie showing of anticipation with regards to claims 2 and 13 has not been established, and withdrawal of the rejection is respectfully requested.

Claims 3, 4, 6, 14, and 17 are believed to be allowable based on dependence from an allowable claim.

Regarding claim 25, the Patent Office references FIG. 12A, element 5, col. 2, lines 10-65 of Clark, Jr. et al. for teaching of “carrier material is thermally conductive” as claimed in claim 25. Claim 25 is a dependent claim of independent claim 23. The Clark, Jr. et al. reference fails to teach “a carrier material . . . disposed with a plurality of items .

. . including magnetic shielding alloy”, as claimed in claim 23. Therefore, for the same reasons stated above with regards to claims 2 and 13, claim 23 is believed to be allowable. Thus, claim 25 is believed to be allowable based on dependence from an allowable claim.

Claim Rejection Under 35 U.S.C. §103

Claims 5 and 15-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark, Jr. et al. (U.S. 5,785,913) in view of Ameen et al. (U.S. 5,591,034). Applicant respectfully traverses this rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Claim 5 depends from independent claim 2 while claims 15-16 depend from independent claim → 13. The Clark, Jr. et al. and Ameen et al. references fail to teach an adhesive, “disposed with a plurality of items . . . including magnetic shielding alloy” as claimed in claims 2 and 13. Instead, Clark, Jr. et al. teaches a hardened particle filled polymer with enhanced mechanical, electrical, or thermal characteristics while Ameen teaches a conformable adhesive for thermal conduction. Further, nowhere in the submitted references is there a → teaching of shielding. Therefore the references fail to establish *prima facie* obviousness and withdrawal of the rejection is respectfully requested.

Further, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. It is well established that

[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use

hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Patent Office has selected portions from the references to arrive at the present invention. However, none of the references supply the motivation for their combination as proposed. Moreover, no motivation or suggestion for modifying or combining the cited references as suggested is found in the prior art in general. Rather, the references are relied upon for their teaching of selected elements, but the motivation to combine the elements in the combination as set forth by the present application has not been supplied, absent the impermissible use of the present application as a manual or template. Since the references do not teach or suggest the desirability of the modification, and no such motivation is provided in the prior art in general, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

→ In making the rejection to claims 5, 15, and 16 under 35 U.S.C. §103 the Patent Office first asserts Clark, Jr. et al. for teaching a first surface is included on an integrated circuit and the second surface is included on a heat sink. The Patent Office then correctly states that the Clark, Jr. et al. reference “does not teach an adhesive is used for bonding between the first component surface including an integrated circuit, and the second component surface including on a heat sink.” The Patent Office then cites the Ameen et al. reference as teaching “an adhesive” to cure the defects of the Clark, Jr. et al. reference. The Patent Office states that it would have been obvious to modify Clark, Jr. et al. according to Ameen et al. However, Clark, Jr. et al. teaches a hardened polymer disposed
→ with magnetic particles while Ameen et al. teaches a conformable adhesive. Neither of the references teach or suggest combining the hardened particle filled polymer of Clark Jr. et al. with the conformable adhesive of Ameen et al. in order to bond a first surface to a second surface. Therefore, the references fail to establish obviousness and it is requested that the rejection be withdrawn.

“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P. 2131.02*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed.

Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The cited references teach away from the claimed invention. The Clark, Jr. et al and Ameen et al. references fail to teach to an adhesive having electromagnetic capability (EMC) shielding characteristics provided by use of items disposed in the adhesive, as taught by claims 2 and 13 of the present invention. Instead, the Clark, Jr. et al. reference, teaches to a hardened particle filled polymer having increased mechanical, electrical, or thermal characteristics and does not teach to an adhesive with electromagnetic capability (EMC) shielding. The Ameen et al. reference merely teaches to a thermally conductive adhesive and does not teach to an adhesive with electromagnetic capability (EMC) shielding. Therefore, the references would lead a reasonable person away from the claimed invention and fail to carry the burden of a showing of obviousness. Applicant respectfully requests the withdrawal of the obviousness rejection.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *M.P.E.P. 2143.01, In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The hardened polymer of Clark et al. combined with the conformable adhesive of Ameen et al. does not teach or suggest the claimed invention. Rather than the adhesive with electromagnetic capability shielding characteristics of the present invention, the combination of the above references would provide a hardened polymer with an adhesive strip stuck to it. This would change the principle of operation of the prior art inventions and would not provide the claimed invention. Thus, the references fail to provide the claimed invention and carry the burden of showing obviousness.

Claims 7-11 and 18-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark, Jr. et al. (U.S. 5,785,913). Applicant respectfully traverses this rejection.

As stated above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Regarding claims 7-11 and 18-24. The Patent Office references Clark, Jr. et al. and asserts that “[a] change in size is generally recognized as being within the level of

ordinary skill in the art.” However, the Clark, Jr. et al. reference fails to teach or suggest the limitation directed to providing “items . . . including magnetic shielding alloy items” with “electromagnetic capability (EMC) shielding” as claimed in claims 7, 10, 11, 18, 21, 22, and 23 of the present invention. Instead, Clark, Jr. et al. teaches to particles within a hardened polymer which increase mechanical, electrical, or thermal surface characteristics. Further, nowhere in the Clark, Jr. et al. reference does it teach or suggest shielding. Therefore, it is respectfully submitted that a *prima facie* showing of obviousness with regards to claims 7, 10, 11, 18, 21, 22, and 23 has not been established, and withdrawal of the rejection is respectfully requested.

Claims 8 and 9 are believed to be allowable based on dependence from allowable claim 7. Claims 19 and 20 are believed to be allowable based on dependence from allowable claim 18. Claim 24 is believed to be allowable based on dependence from allowable claim 23.

Amendment of Claims After Final Action – 37 CFR §1.116

“After a final rejection or other final action (§ 1.113) in an application, . . . amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action”. 37 CFR § 1.116(b). Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. MPEP § 714.12.

Applicant respectfully submits that the amendment to claims 2, 7, 10-11, 13, 18, and 21-23 and the addition of new claims 26 through 48 place the present application in a condition for allowance or alternately in better form for appeal. By including the limitation of a ceramic ferromagnetic material and a magnetic shielding alloy, amended independent claims 2, 7, 10-11, 13, 18 and 21-23 provide a material which is not provided by prior art in general and the cited references specifically. New independent claims 26, 31, 36, 41, and 46 recite providing a “plurality of items includes a magnetic shielding alloy”, thus encompassing a limitation which has not been disclosed, taught, or suggested by any reference of record in the present application.

Because the amendment merely requires only a cursory review by the examiner, applicant respectfully requests that the amended claims and new claims be entered under

MPEP § 714.13. “The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance...” MPEP §714.13.

Amended claims 2, 7, 10-11, 13, 18, and 21-23 and new claims 26 through 48 merely require only a cursory review by the examiner and do not require a further search of relevant art due to the fact that the elements recited in amended independent claims 2, 7, 10-11, 13, 18 and 21-23 and the new independent claims 26, 31, 36, 41, and 46 have been included within the claims of the present application since its filing date. As such, the examiner has already considered the recited elements and may limit the scope of review of the amended independent claims 2, 7, 10-11, 13, 18 and 21-23 and the new independent claims 26, 31, 36, 41, and 46 to the art of record in the present application. Since the limitations recited in amended independent claims 2, 7, 10-11, 13, 18 and 21-23 and the new independent claims 26, 31, 36, 41, and 46 clearly encompass a new invention that has not been recited in any prior art reference of record or combination of references of record, amended claims 2, 7, 10-11, 13, 18 and 21-23 and the new independent claims 26, 31, 36, 41, and 46 place the present application in a condition for allowance without requiring more than a cursory review by the examiner.

Further, amended claims 2, 7, 10-11, 13, 18 and 21-23 and new independent claims 26, 31, 36, 41, and 46 merely adopt examiner suggestions made in the Response to Argument section of the final office action. The relevant part of the passage reads:

“However, Applicant recites in claims 2, 13 and 13 “an item of the plurality of items includes at least one of ceramic ferromagnetic material an magnetic shielding alloy”. Applicant only recites one of two items and does not recite both “ceramic ferromagnetic material” and “magnetic shielding alloy”. Therefore, the limitations in claims 2, 13 and 23 still read on the reference of Clark, Jr. et al...”

The features noted by the examiner, “ceramic ferromagnetic material” and “magnetic shielding alloy” are included in the amended claims. The feature noted by the examiner, “magnetic shielding alloy” is included in the new claims. Specifically, amended independent claims 2, 7, 10-11, 13, 18 and 21-23 recite “a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics, wherein an item of the plurality of items includes a ceramic ferromagnetic material and a magnetic shielding alloy.” Additionally, the new

independent claims recite "a plurality of items disposed in the adhering material, the plurality of items having electromagnetic capability (EMC) shielding characteristics, wherein an item of the plurality of items includes a magnetic shielding alloy." The associated information encompasses the Examiner suggestions and places the claims in a condition for allowance.

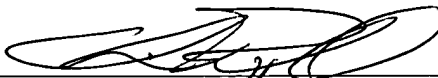
Therefore, it is respectfully requested that the examiner enter the amended claims 2, 7, 10-11, 13, 18 and 21-23 and the new claims 26 through 48 under 37 CFR §1.116 as they place the application in condition for allowance or in better form for appeal (MPEP §714.12), adopt the examiner suggestions (MPEP § 714.13), and require no more than a cursory review (MPEP §714.13).

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
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